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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,462	04/18/2001	Alexander Walland	I/1152/1088	7878

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/12/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,462

Applicant(s)

Walland et al

Examiner

J. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/21/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 5 and 7-17 is/are pending in the application.
- Of the above claim(s) 8, 11, 12 and 14-16 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 7, 9, 10, 13 and 17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Claims 1-3, 7, 9, 10, 13 and 17 are under consideration in this application.

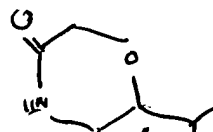
Claims 8, 11, 12 and 14-16 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b). Again, claims 11 and 16 are held withdrawn from consideration since they are drawn to a **process of making**. Applicants **elected compounds only**.

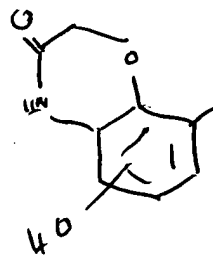
Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2003 has been entered.

Election/Restriction

The restriction requirement is deemed sound and proper and is hereby maintained for the reasons clearly set forth in the record.

Prosecution is hereby being continued with the examination of the elected compound wherein R¹ represents  and R², R⁵ and R⁶ as set forth in claim 1, exclusively.



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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 7, 9, 10, 13 and 17 are rejected under 35 U.S.C. 103(a) as being obvious over the combined teachings of Schromm et al. I, II for the reasons set forth in the record.

Schromm et al. I, II generically embrace the instant compounds wherein R⁵ represents methoxy and dimethylamino. Note, for example, the compounds recited in claim 1 of Schromm et al. I.

Further, example 30 of Schromm et al. I, II differs from the compound claimed herein as having a hydroxy group rather than applicants' methoxy group. The motivation to make these compounds is their close structural similarities to the disclosed compound. Note that the

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disclosed compound has pharmaceutical activity, thus the skilled artisan would expect such structurally similar compounds to possess similar properties. While homology is considered to be present even if true “homology” is not present, such does not defeat the prima facie case of obviousness raised by the art. Attention, in this regard is directed to In re Druey et al., 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court’s opinion, stated:

that in “We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants the term homologue is used by chemists at times in a broad sense, and at other times a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.” 50 CCPA 1541.

Also, as the Court stated in In re Payne et al., 606 F.2d 302, 203 USPQ 245 at 255 (CCPA 1979):

“the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.”

In addition, any question of why would one conceive and use the similar compounds (*i.e.* “motivation”) is answered by the Court in In re Gyurik et al., 596 F.2d 1012, 201 USPQ 552 at 557.

“In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

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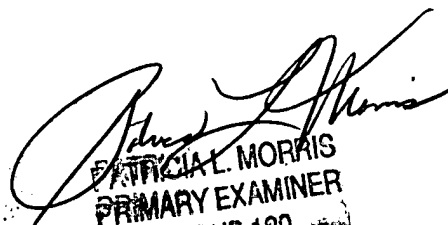
No unexpected or unobvious results are noted. Attorney's arguments do not take the place of objective evidence. Again, applicants have failed to point to any objective evidence which demonstrates that the claimed compounds as a class exhibit any properties which are actually different from the closest prior compounds embraced by Schromm et al. I, II. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

plm
September 11, 2003


PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120